

Remarks

The Section 102 Rejection

The Examiner has rejected claims 1-3 as anticipated by U.S. Patent 5,913,700 to Goergen. As repeatedly indicated by the courts, anticipation requires that all of the elements and limitations of the claims be found within a single prior art reference. There must be no difference between the claimed invention and the disclosure provided by the reference, as viewed by a person of ordinary skill in the field of the invention. Scripps Clinic & Research Found. v. Genentech, Inc., 927 F.2d 1565 (Fed. Cir. 1991). Applicant respectfully submits that the Examiner has misinterpreted Goergen and that Goergen does not teach every element of the claims; therefore, the invention, as claimed herein, is not anticipated by Goergen.

According to the Examiner, Goergen discloses a method of discouraging the roosting of birds by identifying a roosting zone “and then applying a slide (Fig 4:30) which imposes a plurality of angled surfaces (Fig 4:F and 30) to inhibit a bird’s standing.” Applicant respectfully submits that the Examiner has failed to show the presence in Goergen of all the limitations of claim 1. Claim 1 recites:

1. A method of discouraging the roosting or nesting of birds on structures comprising the steps of identifying roosting zones on the structure and applying thereto a slide comprising a formed sheet of material having a slick outer face and mounted to impose a plurality of angled slide surfaces that inhibit a bird’s standing.

As explicitly explained in the Pre-Brief Hearing Statement in this case:

“Goergen does not disclose all the limitations of claim 1. In particular, Goergen does not disclose a formed sheet of material . . . mounted to impose a plurality of angled surfaces that inhibit a bird’s standing.

“As may readily be seen in FIGs. 1-4, the Goergen device presents a single angled slick surface (identified as 4) to inhibit standing birds. A single surface is not a plurality of surfaces. (Applicant notes that Goergen FIGs 1 and 2

show three sides to the structure but only one surface is imposed so as to inhibit the bird.) To wriggle out of this dilemma, the Examiner misinterprets Goergen FIG. 4 as showing a “plurality of angled surfaces (FIG. 4: F, 30).” [Office Action, P. 2] Here the Examiner fails to comprehend what Goergen discloses (or perhaps did not read the specification). FIG. 4 shows a plastic strip (30) inclined at an angle and fixed to the horizontal and vertical surfaces by “beads of adhesive foam (f).” [Col 2, l. 59-64]

“There is no possible way that these beads of adhesive can be considered additional angled slide surfaces combined with the plastic sheet. Moreover, these beads of adhesive are not part of the angled plastic sheet and thus do not meet the limitation that the device be a formed sheet having a plurality of angled surfaces that present to the birds. The Examiner’s argument that Goergen discloses an exposed surface that “contains various angles capable of being exposed to bird activity” is plain wrong; Goergen shows a single slide surface and two beads of adhesive.”

[Pre-Brief Hearing Statement, p. 1]

Applicant hereby re-asserts this position. Applicant notes that the above discussion does not rely upon the “formed” nature of the sheet in claim 1 but advises that the term does not refer to the method of construction of the sheet but rather that its structure is already characterized (i.e., has a form) before the sheet is applied to the roosting zone. In any event, the limitation is not necessary to distinguish the Goergen reference.

Claims 2 and 3 depend from claim 1 and are not anticipated where claim 1, as shown, is not anticipated.

The Section 103 Rejections

The Examiner has rejected claims 4, 5 and 10 as unpatentable over Goergen under 35 USC 103(a). Claims 4, 5 and 10 recite:

4. The method of claim 2 wherein the slide is formed as a pyramid.
5. The method of claim 2 wherein the slide is formed as a triangular prism in which the side affixed to the roosting zone is partially open and the slide cross section is an inverted V.
10. The method of claim 2 wherein the slide is formed as a partial pyramid.

First, it is to be noted that claims 4, 5, and 10 are dependent from claim 1. The Examiner makes no showing that claim 1 itself is obvious over Goergen and relies upon the erroneous (as demonstrated above) anticipation rejection. Because claim 1 is valid, the dependent claims are also valid.

With respect to Examiner's rejection under 35 U.S.C. 103(a), "in proceedings before the Patent and Trademark Office, the Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art." In re Fritch, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). "[I]dentification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant." In re Kotzab, 217 F.3d 1365, 1369-70, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000).

An adequate showing of motivation to combine requires "evidence that 'a skilled artisan,' confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed." Ecolochem, Inc. v. Southern Calif. Edison Co., 227 F.3d 1361, 1375, 56 USPQ2d 1065, 1075 (Fed. Cir. 2000) (quoting In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998)). "Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight." In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

In making the rejection, the Examiner mis-reads the scope of Goergen. Goergen does not disclose a generic method of discouraging the roosting of birds by “applying a slide sheet to the roosting zone.” The Goergen method, both claimed and described, is for “preventing birds from roosting on the ledges of buildings and under bridges” [Col 1, lines 21-22]. Goergen’s method involves the application of specific structural components to the treatment zone, with the alternatives shown in Goergen’s Fig 1 and Fig 4. The structural limitations in Applicant’s claims 4, 5 and 10 are not disclosed or suggested in Goergen. The Examiner’s bald statement that it would be obvious to “use[e] any suitable shape to deter birds” is unsupported and fails the test for taking official notice without citing a prior art reference. See MPEP 2144.03(A) (Not proper where asserted facts not capable of instant and unquestionable demonstration as being well-known)

The Examiner rejects claim 11 as obvious in light of Goergen. Claim 11 recites:

11. A method of discouraging the nesting or nesting of birds on rooftop structures comprising the steps of identifying roosting zones on the rooftop structure and applying thereto a slide comprising a sheet of material having a slick outer surface and mounted to impose an angled surface that inhibits a bird’s standing, wherein the slide comprises a sheet that follows a slope of the rooftop structure and covers the nesting zone.

The Examiner states that Goergen discloses applying a slide to “inhibit a bird’s standing on building structures, such as ledges.” That is correct. Goergen illustrates attaching an angled sheet on a building ledge or an exposed I-Beam (see Figs 1-4). This sheet is attached at an angle that does not follow the slope of either the vertical or the horizontal face of the ledge or beam. See Goergen Fig. 1. Goergen does not disclose, or even hint at, placing a slide sheet that follows a slope of a rooftop.

To overcome this logic gap, the Examiner uses upside-down reasoning, stating that “roof structures inherently contain ledges.” Not only is this contention both unsupported and wrong, but it utterly fails to connect Goergen to Applicant’s invention. Even if it were true that roof structures inherently contain ledges, it is demonstrably false that buildings with ledges inherently have sloped roof tops. Consequently, the Examiner has failed to make a *prima facie* case that Goergen is applicable at all to claim 11.

Moreover, Goergen suggests nothing about the claim limitation “follows a slope of the roof top structure.” Indeed, Goergen teaches away from such a limitation, as it shows placement of the sheet at a slope that is different from the horizontal and vertical slopes of the structure to which it is attached.

The Examiner has rejected claim 12 as obvious over Goergen in view of U.S. Patent 6,546,676 to Wiesener et al. The Examiner’s reasoning is utterly faulty. Claim 12 recites applying a bead of silicone around the periphery to prevent anchoring of nesting materials. According to the Examiner, one would use Wiesner’s silicone adhesive as a “weather resistant seal “to keep out water,” but there is no reason to even consider putting a weather resistant seal on a sheet that sits on top of a roof slope (which should already be weather resistant).

Additionally, claim 12 is dependent from claim 11 and therefore is allowable because claim 11 is allowable.

Applicant respectfully submits that claims 1-10, as amended, are shown by the foregoing to be in proper form, supported by the specification, and novel and unobvious in light of the references cited and those references considered pertinent to Applicant’s disclosure. Thus, Applicant submits that the present application is in condition for allowance. Favorable

reconsideration and withdrawal of the objections and rejections set forth in the above-noted Office Action and a Notice of Allowance are requested.

Respectfully submitted,



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